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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,420	09/08/2003	Jose E. Lizardi	022956-0238	9019

21125 7590 01/25/2007
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EXAMINER

MENDOZA, MICHAEL G

ART UNIT	PAPER NUMBER
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3734

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/657,420

Applicant(s)

LIZARDI, JOSE E.

Examiner

Michael G. Mendoza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70, 71 and 73-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 86-90 is/are allowed.
- 6) ☒ Claim(s) 70, 73, 75-79 and 81 is/are rejected.
- 7) ☒ Claim(s) 71, 74, 80 and 82-85 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 14 December 2006 have been fully considered but they are not persuasive. In response to the applicant argument that Giannuzzi does not disclose a groove, the examiner disagrees. The applicant does not disclose the specific size of the groove. A groove is a channel or a depression. Because the applicant does not define the specific size of the groove the notch disclosed by Giannuzzi reads on the limitation. Furthermore the applicant does not specifically state where the groove is. The only limitation for the placement of the groove is that it is located at the distal end of the anchor. Nor does the applicant disclose the length of the distal end or the suture engaging tip. Therefore the tip as shown by Giannuzzi reads on the limitations of the claim.
2. In response to applicant's argument that the device of Giannuzzi is not a suture anchor, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Furthermore, a suture is not positively claimed.
3. Applicant's arguments, see 5 and 6, filed 14 December 2006, with respect to the 35 USC 102(b) and 35 USC 103(a) rejections to Chow have been fully considered and are persuasive. The 35 USC 102(b) and 35 USC 103(a) rejections of claims 70, 73, 75, 78, 81, and d82-85 has been withdrawn.

Claim Rejections - 35 USC § 102

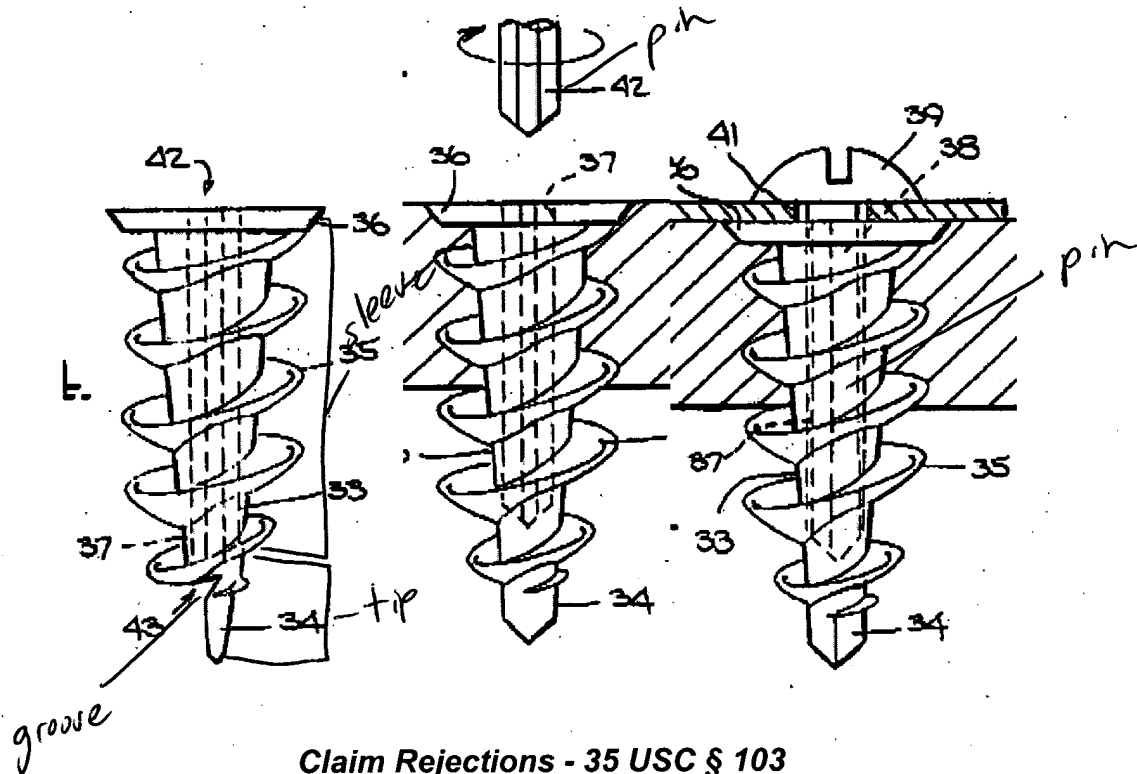
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 70, 73, 75, 76, 78, 79, and 81 are rejected under 35 U.S.C. 102(b) as being anticipated by Giannuzzi 4892429.

6. Giannuzzi teaches a system comprising: a radially expandable anchor including a bore extending longitudinally from a proximal end, a tapered tip at a distal end, the tip having formed therein a groove, wherein the taper of the tip extends a distance at least equal to the length of the groove; an expander pin; wherein the anchor is comprised of an expandable sleeve in engagement with the tip; wherein the anchor includes an external surface feature; wherein the external surface feature is selected from the group consisting of ridges, wedges, and fins; wherein the expander pin includes a surface feature effective to assist in the radial expansion of the sleeve; wherein the anchor further includes a pair of longitudinally extending slits extending from the proximal end thereof (col. 7, lines 31-37); and wherein the expander pin is tapered.



Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giannuzzi.

9. Giannuzzi teaches the system of claim 70. It should be noted the Giannuzzi fails to teach wherein the expander pin includes a tool-engaging bore. However, it is well known in the art of fasteners that a bore (such as a bore used for engagement for an allen wrench) is an alternate for a slot or a Phillips type engagement for use with a driving tool. Therefore, it would have been obvious to one having ordinary skill in the art

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at the time the invention was made to use a bore as an obvious alternative to the slot used by Giannuzzi.

Allowable Subject Matter

10. Claims 86-90 are allowable over the prior art of record.
11. Claims 71, 80, and 82-85 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 9:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MM

A handwritten signature in black ink, appearing to read "M J Hayes", with a stylized flourish at the end.

MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER